

REMARKS/ARGUMENTSClaim Rejections – 35 USC §112

The pending claims were all rejected as being indefinite because it was unclear what was meant by the grating element or the grism dispersing away from the beam path outer portions. The independent claims 1, 3, 8, 46, and 55 have all been amended herein to clarify that the grating element or the grism disperses outer portions of the spectral distribution away from the beam path. These amendments are intended to clarify, not change, the scope of the pending claims.

Other amendments are made herein to the preamble of certain claims to clarify that the preamble of each claim refers to a laser system.

Claim Rejections – 35 USC §102

The pending claims were all rejected as anticipated by Vogler, et al, U.S. Patent Publication US 2002/0114362.

Applicants traverse this rejection for two reasons.

First, it is not seen why the Vogler publication is considered to be prior art to the present application under §102(e). The Vogler publication is based on Application No. 10/116,903, which is a division of Application No. 09/738,849. Application No. 09/738,849 was filed on December 15, 2000, whereas the present application was filed nearly six months earlier, on June 22, 2000. The effective filing date of the Vogler Application No. 10/116,903 for purposes of §102(e) is December 15, 2000, after the filing date of the present application. The Vogler publication is not “before the invention by the applicant for patent” as required by §102(e) because the Vogler Application 10/116,903 has an effective filing date that is nearly six months after the filing date of the present application.

Even if one considers the provisional applications upon which both applications claim domestic priority, the Vogler Application is not prior to the present application.¹ The Vogler Application 10/116,903 purports to claim domestic priority from four provisional applications, although two of the provisional applications (60/128,227 and 60/140,531) were filed more than a year before the December 15, 2000 filing date of Application No. 09/738,849. The other two

¹ It is the filing date of a non-provisional application that is later published or patented that determines the effective date of a §102(e) reference, not the filing date of any related provisional applications.

provisional applications (60/173,993 and 60/170,919) are jointly relied upon by both the Vogler Application 10/116,903 and the present application. The present application also relies on two additional provisional applications (60/140,532 and 60/167,835) that were filed even earlier. Applicants do not understand how the Vogler publication or patent application can be characterized as prior to the present application, since it was filed later and has a priority date of no earlier than the present application.

Second, the content of the Vogler publication applied against the claims of the present application is the invention of Juergen Kleinschmidt, who is a co-inventor in both the Vogler Application 10/116,903 and the present application. Dr. Kleinschmidt submits herein a declaration that he "invented the subject matter disclosed in Publication No. US 2002/0014362 A1 that the Patent Examiner relied upon to reject claims in Application No. 09/602,184." Since the disclosure in the Vogler Publication used to reject the claims is not "by another," it cannot be prior art under 35 USC §102(e).

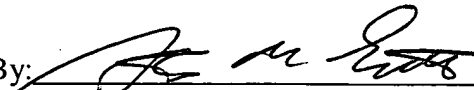
Conclusion

It appears to the Applicants that the present application is now in condition for allowance. If the Examiner has any questions, please call the undersigned at 415-512-1312 x109.

Respectfully submitted,

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